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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,475	10/30/2001	Randy Kish	KIRA 8169US	1279
1688	7590	08/25/2004		
POLSTER, LIEDER, WOODRUFF & LUCCHESI 12412 POWERSCOURT DRIVE SUITE 200 ST. LOUIS, MO 63131-3615			EXAMINER VARGOT, MATHIEU D	
			ART UNIT	PAPER NUMBER
			1732	
DATE MAILED: 08/25/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/021,475

Applicant(s)

KISH, RANDY

Examiner

Mathieu D. Vargot

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 14-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. Applicant is requested to cancel the non-elected claims 14-16 to expedite prosecution.

2. Claims 1-13 and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has amended claim 1 and drafted new claim 17 to include a recitation to die-cutting the OSD "and a data layer of the OSD" in an effort to define over the applied art. However, a careful reading of the instant specification does not reveal exactly where such a recitation is supported. It is noted that applicant has support for die cutting so that the edge of the optical disc is undamaged—ie, so that minimum damage to the data layer adjacent the edge occurs—see page 7, paragraph 22. However, this is not sufficient to support the above-noted language. Indeed, applicant could just as easily be cutting in a region adjacent to a data layer. The issue is compounded since there is no definition as to what this data layer constitutes. Any disc which is recordable has areas which are potential data areas which would be cut, whether or not one intends the areas to actually contain data at some point. Obviously, if the areas are removed, they would not contain readable data after the cutting. However, this does not mean that the areas would not have constituted potential data areas prior to the cutting. Applicant has not defined by "data area" if such constitutes a region which could be used as a data area later (after the cutting) or a region that already contains data (before the cutting). It is submitted that

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applicant has failed to show clear support for cutting through a "data layer" and exactly what such layer constitutes and hence recitations drawn to these aspects are considered to be new matter.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Rohde et al (see column 4, lines 33-37) essentially for reasons of record noting the following.

Applicant's amendment concerning cutting through a data layer has been discussed in paragraph 2, supra, and is submitted to be new matter for reasons set forth therein. At any rate, the applied reference shows in Figure 3E that a circular blank, presumably all (or most all) of which would constitute a potential data layer, is cut with a grinding tool and discloses at column 4, lines 33-37 that such cutting would also be done with a die. Although Rohde et al shows that the area on the OSD which actually contains data (after the cutting) is limited to a region inside the cut area, applicant's disclosure does not define over this and hence the instant claims cannot, either. Certainly, in taking a circular disc and removing portions therefrom, one of ordinary skill would recognize that potential data layer regions are being cut or removed. Since this is what Rohde et al is teaching and apparently what applicant is disclosing, instant claim 1 remains

anticipated. Note that there is no particular order set forth in instant claim 17, and therefore such is "readable on" the process of Rohde et al.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 4, 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rohde et al for reasons set forth in paragraph 3, supra and paragraph 3 of the previous action.

5. Claims 3 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rohde et al in view of Bree for reasons of record as set forth in paragraph 3, supra and paragraph 4 of the previous action.

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rohde et al in view of Japanese Kokai 59-87936 for reasons of record as set forth in paragraph 3, supra and paragraph 5 of the previous action.

7. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rohde et al in view of Bree and Japanese Kokai 59-87936 essentially for reasons of record.

8. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rohde et al in view of Braun et al or reasons of record.

9. Applicant's arguments filed June 1, 2004 have been fully considered but they are not persuasive. First of all, it is believed that the amendment constitutes new matter.

While this was never discussed at the interview, it was not until after a careful review of the specification that such was determined. Applicant has amended the claims in an effort to define over Rohde et al, which reference is submitted by applicant as not cutting through a data layer, while the instant does. However, as already pointed out, there does not appear to be any support for applicant actually cutting through what is in fact a data layer when the cutting occurs, but only that the cutting affords minimal damage to the data layer. This would appear to be precisely what Rohde et al is also doing. It is also not believed that applicant is in fact cutting through an actual existing data layer—ie, a layer with data thereon—or otherwise such data would be lost upon cutting. If applicant intends “data layer” to mean a region which would potentially hold data, then Rohde et al is also teaching this. Due to the lack of disclosure concerning these aspects, it is impossible to determine exactly what applicant means. Whether the disclosure to using a die cutting in Rohde et al is “only an afterthought” or not is immaterial to the rejection, in that a reference is to be considered for all it discloses, not merely preferred embodiments, see *In re Boe*, 148 USPQ 507. The dependent claims are submitted to be properly rejected over the art applied. Note that claim 17 is open with respect to the order of the steps and would include opening the die set and then removing the OSD.

10. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mathieu D. Vargot whose telephone number is 571 272-1211. The examiner can normally be reached on Mon-Fri from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni, can be reached on 571 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Vargot
August 23, 2004

M. Vargot
Mathieu D. Vargot
Primary Examiner
Art Unit 1732

8/23/04